

*REMARKS/ARGUMENTS**The Pending Claims*

Claims 1-36 currently are pending. Claims 13-36 have been withdrawn pursuant to a restriction requirement. Claims 1-12 currently are being examined and are drawn to a cosmetic composition comprising fumed alumina particles. Reconsideration of the claims is respectfully requested in view of the remarks herein.

Discussion of the Amendments to the Specification

The specification has been checked to the extent necessary to determine the presence of all possible minor errors. Accordingly, paragraphs 0016, 0025, 0027, 0032, and 0036 have been amended to correct typographical errors. No new matter has been added by way of these amendments.

Discussion of the Amendment to the Claims

Claim 13 has been amended to delete the phrase “the soft-focus effect of” and to match claims 1-12. This amendment is consistent with the previous amendment to claims 1-12 and with the entirety of the disclosure of the pending application. Support for this amendment also can be found at, for example, paragraphs 0001, 0004, 0019-0022, and 0029 of the specification. No new matter has been added by way of this amendment.

Discussion of the Restriction Requirement

Applicants acknowledge that a complete reply to the final Office Action must include cancellation of nonelected claims or other appropriate action. Applicants maintain the request for rejoinder of any non-examined claims upon an indication of the allowability of any of the examined claims to the extent such non-examined claims are dependent upon, or include the limitations of, any of the allowed claims.

Summary of the Office Action

The Office Action maintains the rejections previously entered against the pending application (see non-final Office Action dated March 29, 2007). In particular, the Office Action sets forth the following rejections:

- (a) claims 1-36 stand provisionally rejected based on statutory-type double patenting under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1-12, 14-25, and 27-38 of co-pending U.S. Patent Application 10/959,614, which has not yet issued;
- (b) claims 1-12 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Application Publication 2003/0064020 (Kogoi et al.) (hereinafter “the Kogoi ‘020 publication”) alone or in view of U.S. Patent 6,333,053 (Simon) (hereinafter “the Simon ‘053 patent”).

Discussion of the Double-Patenting Rejection

Applicants acknowledge that claims 1-12 are provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1-12, 14-25, and 27-38 of co-pending U.S. Patent Application 10/959,614. Applicants appreciate that the Office will continue to note this “provisional” rejection until it is the only rejection remaining against either the pending application or against U.S. Patent Application 10/959,614. Applicants will address this rejection if and when the referenced application issues as a patent and the rejection is no longer provisional.

Discussion of the Obviousness Rejections

The Office Action maintains the previous rejection of claims 1-12 as allegedly encompassing obvious subject matter over the Kogoi ‘020 publication alone or in view of the Simon ‘053 patent. Claim 1 of the pending application requires a cosmetic composition comprising about 3 wt.% or more fumed alumina particles. Pending claims 2-12 depend upon claim 1 and, therefore, incorporate all of the limitations of claim 1. The Kogoi ‘020 publication, either alone or in combination with the Simon ‘053 patent, fails to disclose or suggest a cosmetic composition comprising about 3 wt.% or more fumed alumina particles.

Further, contrary to the Office Action's assertions, a person of ordinary skill in the art would not have been motivated by the disclosure of the Simon '053 patent to modify the disclosure of the Kogoi '020 publication in such a way as to arrive at the claimed invention. As such, Applicants maintain that the combination of the Kogoi '020 publication and the Simon '053 patent fails to render the claimed invention obvious.

The Office Action acknowledges that the Kogoi '020 publication fails to disclose the use of 3 wt.% or more fumed alumina particles in a cosmetic composition (Office Action, pp. 8-9), but relies on *In re Preda*, 401 F.2d 825, 159 U.S.P.Q. 342 (C.C.P.A. 1968), for its suggestion that it is proper to consider not only the specific teachings of a reference, but also any inferences that one skilled in the art would "reasonably be expected to draw" from the reference. See *In re Preda*, 401 F.2d at 826-27, 159 U.S.P.Q. at 344. The Office Action essentially asserts, therefore, that a person of ordinary skill in the art, upon considering the disclosure of the Kogoi '020 publication, would reasonably infer that about 3 wt.% or more fumed alumina particles should be included in a cosmetic composition.

Contrary to the Office Action's assertions, however, the Kogoi '020 publication discloses nothing with respect to particular amounts of fumed alumina that can be included in cosmetic compositions, and *In re Preda* is therefore inapposite. The claims at issue in *In re Preda* were directed to a particular reaction process carried out at a temperature of about 750° C - 830° C. *In re Preda*, 401 F.2d at 825-26, 159 U.S.P.Q. at 343. A prior art reference sought low-temperature effectiveness for the same types of reactions and, as such, disclosed reaction temperatures of 700° C and below. *Id.* However, the same reference also explicitly "recogni[zed] that higher temperatures could be employed with attendant disadvantages," and referred to a similar, separately patented process that employed reaction temperatures at 800° C - 1000° C. *Id.* Because the "total disclosure" of the reference, including its recognition of the higher temperature prior art process, the court affirmed the finding that the reference anticipated the higher-temperature claims. *In re Preda*, 401 F.2d at 826-27, 159 U.S.P.Q. at 343-44. In the present case, by contrast, the Kogoi '020 publication provides no teaching whatsoever with respect to possible or preferred amounts of fumed alumina particles for use in cosmetic compositions (see the Kogoi '202 publication, paragraph 0079). Nor does it address the particular soft-focus benefits provided by the use of fumed alumina in such compositions, in any amount. As such, a person of ordinary skill in the art, on considering

the teachings of the Kogoi '020 publication, would not reasonably be expected to draw any inference whatsoever with respect to the use of any particular amount of fumed alumina in cosmetic compositions. *See In re Preda*, 401 F.2d at 826-27, 159 U.S.P.Q. at 343-44. Thus, the disclosure of the Kogoi '202 publication would not motivate a person of ordinary skill in the art to modify the disclosure of the Kogoi '202 publication to arrive at the claimed invention.

The Office Action further relies on *In re Boesch*, 617 F.2d 272, 205 U.S.P.Q. 215 (C.C.P.A. 1980), for the proposition that "discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art" (Office Action, p. 10). *See In re Boesch*, 617 F.2d at 276, 205 U.S.P.Q. at 219. The Office Action essentially asserts, therefore, that a person of ordinary skill in the art, upon considering the disclosure of the Kogoi '020 publication, would "optimize" the amount of fumed alumina in a cosmetic composition to produce the desirable soft-focus effects disclosed by the pending application, thereby resulting in a cosmetic composition comprising about 3 wt.% or more fumed alumina particles.

Importantly, however, the Kogoi '020 publication discloses nothing to lead a person of ordinary skill in the art to believe that fumed alumina is a known "result effective variable" that produces soft-focus effects in a cosmetic composition. *In re Boesch* is therefore inapposite. The claims in *In re Boesch* were directed to a nickel-based alloy that included copper, chromium, and nickel elements, among others, present in the alloy at weight percentages within particular ranges, such that the alloy exhibited a specific electron vacancy (N_v). *In re Boesch*, 617 F.2d at 273-74, 205 U.S.P.Q. at 216. The cited art included two prior art references that disclosed a nickel-based alloy comprising elements in ranges that overlapped the claimed ranges. *In re Boesch*, 617 F.2d at 274-75, 205 U.S.P.Q. at 217-18. Neither reference, however, expressly disclosed the optimum N_v value claimed for the alloy. *Id.* Because the N_v value was determined according to an equation that related the amounts of the particular elements in the alloy, the ranges of which were disclosed by the prior art, and because another reference explained the benefits of optimizing the N_v value, the court held that "the prior art would have suggested the kind of experimentation necessary to achieve the claimed composition, including the proportional balancing described by [applicant's] N_v equation." *In re Boesch*, 617 F.2d at 276, 205 U.S.P.Q. at 219 (internal

quotation marks omitted). As noted above, in the present case, the Kogoi '020 publication does not disclose any range of fumed alumina particles to include in a cosmetic composition, let alone a range that overlaps that of the pending claims. Moreover, and also unlike the prior art in *In re Boesch*, the Kogoi '020 publication provides no teaching with respect to the soft-focus benefits that result from optimization of the amount of fumed alumina in a cosmetic composition, and thus provides no suggestion for the experimentation that would be necessary to arrive at the claimed range.

Because the subject matter of claim 1 of the pending application is patentable over the disclosure of the Kogoi '020 publication, the subject matter of all claims dependent upon claim 1, i.e., pending claims 2-12, is patentable over the disclosure of the Kogoi '020 publication. Nonetheless, in response to the Office Action's assertion that the subject matter of claims 7, 10, and 11 is obvious over the Kogoi '020 publication because of "the teaching implied from the reference that the particles having [a] diameter less than 45 μm [are] present in an amount of 99.05%" (Office Action, p. 9), Applicants note that the disclosure of a composition comprising particles having a diameter greater than 45 μm in an amount of 0.05 wt.% or less impliedly teaches nothing with respect to particles having a diameter of less than 30 μm or greater than 5 μm . The specification of the present application discloses a preferable agglomerate particle size of about 30 μm or less because "[p]articles that are too large can produce an undesirable texture in the cosmetic composition" (paragraph 0022). The Kogoi '020 publication, on the other hand, discloses that, preferably, the composition comprises particles of an agglomerate size greater than 45 μm in an amount of 0.05 wt.% or less, for optimum use in chemical-mechanical polishing applications, in particular, to prevent scratching while providing the required abrasiveness (see paragraphs 0029-0030). The Kogoi '020 publication teaches nothing with respect to the optimum agglomerate size for cosmetic applications. Moreover, the Kogoi '020 publication teaches nothing with respect to the narrow particle size distribution recited in certain of the pending claims (see, e.g., claim 7 of the pending application, which requires that "70 wt.% or more of the fumed alumina particles have an aggregate particle size of 300 nm or less"; see also paragraphs 0021-0022). Accordingly, contrary to the Office Action's assertions, the Kogoi '020 publication does not provide any teaching – express or implied – to lead a person of ordinary skill in the art to arrive at the subject matter of pending claim 7, 10, or 11.

Applicants maintain that the Simon ‘053 patent fails to cure the deficiencies of the Kogoi ‘020 publication. The Office Action asserts that the pending claims, although directed to fumed alumina, “[do] not exclude other shapes as disclosed by [the Simon ‘053 patent]” (Office Action, p. 10). Contrary to the Office Action’s assertions, the pending claims are directed solely to fumed alumina, which excludes the polyhedral alumina disclosed by the Simon ‘053 patent. The pending application makes this distinction clear: “The fumed alumina particles are substantially different in form, appearance, and physical and/or chemical characteristics from other forms of alumina, such as plate-like or flake-like alumina. While these forms of alumina may form loosely associated agglomerate particles, they are not comprised of aggregate particles, nor are the primary particles spherical in shape” (paragraph 0016). Accordingly, the fumed alumina of the pending claims does exclude alumina as disclosed by the Simon ‘053 patent. The Simon ‘053 patent similarly confirms this distinction: “these oxides [i.e., aluminum oxide] must be cut along crystalline planes and in particular along triclinic, rhombohedral or monoclinic lattice planes but also cubic, quadratic or orthorhombic lattice planes[,] or be obtained by crystalline growth and exhibit such lattices” (col. 2, lines 35-39). The Simon ‘053 patent fails to disclose a cosmetic composition comprising fumed alumina in any amount, let alone in an amount of about 3 wt.% or more.

As such, the combination of the Kogoi ‘020 publication and the Simon ‘053 patent fails to disclose or suggest the subject matter of the pending claims. In particular, the combination fails to disclose or suggest the use of 3 wt.% or more fumed alumina particles in a cosmetic composition.

Furthermore, contrary to the Office Action’s assertions, a person of ordinary skill in the art would not have been motivated by the disclosure of the Simon ‘053 patent to modify the disclosure of the Kogoi ‘020 publication to arrive at the subject matter of the claimed invention. The Simon ‘053 patent is not directed to fumed alumina particles, and while the Kogoi ‘020 publication and the pending claims are limited to fumed alumina particles, the Simon ‘053 patent is expressly limited to a different type of metal oxide particle (see, e.g., col. 1, lines 35-37: “The inventors have discovered, surprisingly, a novel type of particulate phase which makes it possible, by virtue of the shape of its particles, to obtain novel optical effects . . .”). Thus, the disclosure of the Simon ‘053 patent would not have motivated a

person of ordinary skill in the art to modify the disclosure of the Kogoi '020 publication to arrive at the claimed invention.

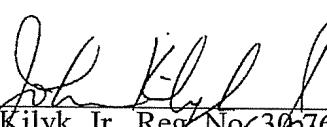
The teaching and benefits of including about 3 wt.% or more fumed alumina particles in a cosmetic composition are provided only by Applicants' disclosure accompanying the pending claims. To conclude that the subject matter of the pending claims is obvious over the combination of the Kogoi '020 publication and the Simon '053 patent is to make improper use of hindsight on viewing the disclosure accompanying the pending claims.

In view of the foregoing, the Kogoi '020 publication and the Simon '053 patent fail to disclose or suggest all of the elements recited in the pending claims. Moreover, the cited references fail to provide a teaching or suggestion that would have motivated one of ordinary skill to modify or combine the disclosure of the cited references in the manner necessary to arrive at the present invention. For either reason, the subject matter of the pending claims cannot properly be considered obvious over the cited references, and the obviousness rejection should be withdrawn.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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